

REMARKS

By the present amendment, Applicant has amended Claim 12. Claims 1-11 were canceled by the previous amendment filed February 27, 2006. Claims 12-19 remain pending in the present application. Claim 12 is the sole independent claim.

In the recent Office Action, the Examiner *finally* rejected Claims 12-14, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Hagen et al. (U.S. Patent No. 6,491,315) in view of Duerkob. (U.S. Patent No. 4,954,808). Claims 15 and 16-17 stands *finally* rejected under 35 U.S.C. § 103(a) as being unpatentable over Hagen et al. in view of Duerkob, and further in view of Mureller (U.S. Patent No. 6,179,842) and Cipolla (U.S. Patent No. 6,769,704), respectively. The Examiner's objection to Claim 12 because of a minor informality is duly noted. In this regard, Applicant has amended the instant claim at line 7 by inserting -- the -- between "to" and "back". Applicant respectfully submits that amended Claim 12 is devoid of the informality noted of record by the Examiner.

Applicant contends that the Hagen et al. reference taken in combination with Duerkob, or with any of the other ancillary references relied upon of records, fail to reasonably suggest a turn signal step bar having the combination of structural and functional features as defined by the present claims. Reconsideration of the present application is respectfully requested.

The Examiner generally concedes that Hagen et al. fails to teach left and right turn signal lamps respectively disposed proximate the opposite ends of the tubular step bar and electrically connected the vehicle's turn signal circuitry as set forth by the present claims. Notwithstanding, the Examiner concludes it would be obvious to one of ordinary skill in the art to modify the step assembly of Hagen et al. by connecting at least the right and left lamps of the primary reference to the turn signal circuit of a vehicle in light of the teachings afforded by the secondary reference to Duerkob. As pointed out of record by Applicant, the patent to Duerkob describes a lighted turn and stop signal unit for eye level use mounted on the inside rear shelf of an automobile. Duerkob further teaches that his signal unit is light weight and made of a plastic material, which would render it unsuitable as a step for mounting to a trailer hitch. Thus, the eye level, interior mounted signal unit of Duerkob is so structurally and functionally unrelated to the trailer hitch step taught by Hagen et al. that any assumption that one of ordinary skill in the art would likely be motivated to combine these references in the manner suggested by the Examiner is completely unfounded.

Applicant again notes for the record that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3rd 994, 50 USPQ2d 1614 (Fed. Cir. 1999) deprecated

rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

As this court has stated, "virtually all [inventions] are combinations of old elements." (*citations omitted*). ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensoronics, Inc. v. Aerasonic Corp.*, 81 F.3rd 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (*Emphasis added*).

In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at 1457-58.

Applicant contends that one skilled in the art would not be motivated or guided by the prior art to combine these references in the manner suggested by the Examiner since the eye level, interior mounted, light-weight signal unit taught by the secondary reference to Duerkob is so structurally and functionally unrelated to the trailer hitch step of primary reference to Hagen et al. as to make such a combination highly impractical. Moreover, Applicant further contends that the specific teachings afforded by the ancillary references to Muller and Cippolla fail to provide any guidance for combining the primary and secondary references together and fail to supplement the above noted deficiency of the primary reference to Hagen et al. Thus, one of ordinary skill in the art without the benefit of Applicant's own disclosure would not be capable of arriving at the presently claimed invention by combining the references in the manner suggested by the Examiner since none of references cited or applied of record realistically suggests the essential combination of features that forms the basis of the instant claims. For at least these reasons, Applicant respectfully submits that independent Claim 12 and corresponding new dependent Claims 13-19 are allowable over the prior art of record.

Applicant respectfully submits that the present Response properly addressed the issues raised in the outstanding Final Rejection. This proposed Response does not raise any new issues that require further consideration or search and is a *bona fide* effort to satisfactorily conclude the prosecution of

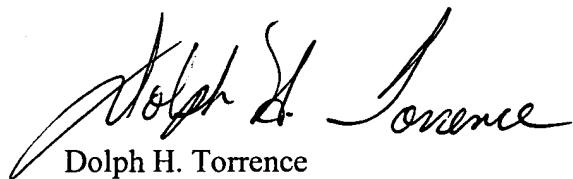
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this application. In the event that an appeal is filed, it is requested that this Response be entered for purposes of appeal.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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